



05 FEB 2009

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In re Application of EBERL et al.	:	
Application No.: 10/551,443	:	DECISION ON
PCT No.: PCT/EP01/11634	:	
Int. Filing: 08 October 2001	:	RESPONSE TO
Priority Date: 07 October 2000	:	
Attorney Docket No.: 101795.56306US	:	NOTIFICATION OF MISSING
For: DEVICE AND METHOD FOR	:	
DETERMINING THE ORIENTATION OF THE	:	REQUIREMENTS
EYE	:	

This is a decision on applicant's Response to Notice to File Missing Parts of Application, filed in the United States Patent and Trademark Office (USPTO) on 07 November 2008. In effect, applicant requests acceptance of the application without the signature of the legal representative of deceased inventor Roland H. Eberl. Applicant also requests a one month extension of time, which is granted.

BACKGROUND

On 07 August 2008, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 07 November 2008, applicant filed, *inter alia*, two executed declarations and a letter from German attorney Matthias Mayer.

DISCUSSION

Two declarations were submitted on 07 November 2008. One declaration is executed by the joint inventor Heinrich Eberl; the other is executed by David Dickerson on his behalf and on behalf of the deceased inventor Roland H. Eberl. Mr. Dickerson annotated his declaration with the following statement: "*signed by David Dickerson in lieu of Roland Eberl who died on Nov. 15, 2007 and whose legal representative refused to sign this declaration".

As stated in MPEP Section 409, if the inventor is dead, insane, or otherwise legally incapacitated, refuses to execute an application, or cannot be found, an application may be made by someone other than the inventor, as specified in 37 CFR 1.42, 1.43 and 1.47, and 37 CFR 1.423. MPEP§ 409.01 - § 409.03(j).

37 CFR § 1.42 requires that in the case of the death of the inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, and apply for

and obtain a patent. 37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

The declarations are unacceptable because they do not identify the legal representative of the deceased inventor and do not state the country of citizenship, residency and mailing address for joint inventor, for the deceased inventor and for his legal representative, in compliance with 37 CFR 1.497(b)(2).

Moreover, in the case where the legal representative refuses to sign the declaration, MPEP Section 409.03(c) Legal Representatives of Deceased Inventor Not Available states:

37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 U.S.C. 117 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor.... *However, 37 CFR 1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see MPEP § 409.03(e)).*
(Emphasis added.)

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).¹

¹ Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the *inventor be presented with the application papers* before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

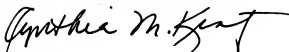
Applicant has not filed a petition under 37 CFR 1.47(a). An English translation of the letter of Matthias Mayer was filed with the declaration. The translated letter indicates that attorney Mayer is "unaware of any activities regarding the present patent. For this reason, I do not consider myself in a position to provide a declaration in lieu of an oath." The letter indicates that Mr. Mayer received *only* the declaration and assignment. Applicant has not submitted evidence that Mr. Mayer was provided with a complete copy of the application. This is insufficient evidence to conclude that Mr. Mayer refuses to sign the declaration as the legal representative of the deceased inventor.

Applicant must file a newly executed declaration, in compliance with 37 CFR 1.497(a) and (b). Applicant may wish to file a petition under 37 CFR 1.47(a).

CONCLUSION

The declarations are unacceptable and do not meet the requirements of 37 CFR 1.497(a) and (b). Applicant may wish to consider filing a petition under 37 CFR §1.47(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.